UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/220,910	12/24/1998	THOMAS E. WALSH	2207-6033	5446

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JOHN C. ALTMILLER
KENYON & KENYON
1500 K STREET, N.W.
SUITE 700
WASHINGTON, DC 20005

EXAMINER
VU, THONG H

ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

PTOL-90A (Rev. 10/06)

	Application No.	Applicant(s)
Office Action Summary	09/220,910	WALSH, THOMAS E.
	Examiner	Art Unit	
	Thong H. Vu	2616	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>07 December 2006</u>.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>42-77</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>42-77</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

1.　　　　Claims 42-77 are pending. Claims 1-41 Cancelled.

2.　　　　The Terminal Disclaimer, filed 12/07/06, has been entered to record.

Response to Arguments

3.　　　　Applicant's arguments, see pages 12-18, filed 12/07/2006, with respect to

Rosenberg-Knowlton have been fully considered and are persuasive. The Rejection of

42-77 has been withdrawn.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
> matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
> conditions and requirements of this title.

4.　　　　Claims 42-77 are rejected under 35 U.S.C. 101 because

the claimed invention is directed to non-statutory subject matter.

　　　　i.e.: Claims 42-55,65-67,69-77 describe the functionality of the software without

　　　　the useful, concrete and tangible result.

the claimed invention lacks patentable utility.

　　　　i.e.: Claims 42-77 did not provide the patentable utility as describe in Fig 6.

5.　　　　Claims 42-77 are rejected under 35 U.S.C. 101 because the claimed invention is

not supported by either a specific and substantial asserted utility or a well established

utility.

　　　　i.e.: the claims 42-77 provide a non-descriptive language wherein the software is

manipulated to read an indicator or address or file name of second document and write

to the first document.

Claims 42-77 are also rejected under 35 U.S.C. 112, first paragraph. Specifically,

since the claimed invention is not supported by either a specific and substantial

asserted utility or a well established utility for the reasons set forth above, one skilled in

the art clearly would not know how to use the claimed invention.

Claim Rejections - 35 USC § 112

6.   Claims 42,56,61,65,68,69 are rejected under 35 U.S.C. 112, second paragraph,

as being indefinite for failing to particularly point out and distinctly claim the subject

matter which applicant regards as the invention.

i.e.: unselected indicator.

Examiner interprets as any parameters or values with provided by the method

and apparatus in the prior art.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 42-77 are rejected under 35 U.S.C. 102(e) as being anticipated by

Thornton et al [Thornton 6,240,429 B1].

7.   As per claim 42, Thornton discloses A method comprising:

The following is a …

processing said primary document (i.e.: a base document) to locate an un-

selected indicator [Thornton, base document, col 11 lines 39-57];

identifying a secondary document (i.e.: a reference document) associated with

said located un-selected indicator [Thornton, reference document, col 11 lines 39-57];

and

attaching said secondary document to said primary document to encapsulate

said secondary document within said primary document [Thornton, created with a link

32, col 11 lines 39-57].

8.   As per claim 43, Thornton discloses said unselected indicator includes at least

one word, and wherein said identifying said secondary document is performed as a

function of said at least one word [Thornton, name-value pairs, col 13 line 66].

9.   As per claim 44, Thornton discloses said unselected indicator includes a plurality

of words, and wherein said identifying said secondary document is performed as a

function of said plurality of words within a predetermined proximity of said un-selected

indicator included in said plurality of words [Thornton, properties, col 11 lines 39-57].

10.   As per claim 45, Thornton discloses associating a predetermined word with at

least one of a filename and a location of said secondary document [Thornton, file name,

location, col 2 lines 1-6],

wherein said primary document includes said predetermined word, and

wherein identifying at least one of said filename and said location of said secondary

document is performed as a function of said predetermined word [Thornton, name-

value pairs, col 13 line 66].

11.   As per claim 46, Thornton discloses said un-selected indicator includes at least

one of a plurality of predetermined words, a plurality of predetermined characters, and

a plurality of predetermined phrases [Thornton, database or directory, col 13 liens 5-35].

12.   As per claim 47, Thornton discloses processing said primary document to locate

said un-selected indicator is performed using syntactic processing [Thornton, distributed

databases, col 6 lines 40-52].

13.   As per claim 48, Thornton discloses said primary document includes an e-mail

message [Thornton, email, col 11 lines 24].

14.   As per claim 49, Thornton discloses sending said e-mail message and said

secondary document attached thereto to a recipient via a communications device

[Thornton, file server, col 11 liens 7-15].

15.   As per claim 50, Thornton discloses sending said primary document and said

secondary document attached thereto to a printing device as inherent feature of Internet

170 [Thornton, Fig 4].

16.   As per claim 51, Thornton discloses sending said primary document and said

secondary document attached thereto to a recipient via facsimile as inherent feature of

Internet 170 [Thornton, Fig 4].

17. ····As per claim 52, Thornton discloses said secondary document is attached to said

primary document at a first instance, said first instance being determined as a function

of user input [Thornton, property instance, a user may specify, col 15 lines 29-41].

18.   As per claim 53, Thornton discloses adding at least one additional indicator to

said un-selected indicator as a function of a user input [Thornton, a user may specify,

col 15 lines 29-41].

19.   As per claim 54, Thornton discloses using natural language processing

techniques [Thornton, Word, col 13 line 10].

20.   As per claim 55, Thornton discloses using word association processing

[Thornton, Word, col 13 line 10]; and using probability matching [Thornton, compared,

col 16 line 46].

21.   As per claim 56, Thornton discloses A document preparation system, comprising:

a first storage device to store said primary document; a second storage device to

store a secondary document; a third storage device to store an indicator [Thornton, Fig

4]; and

a processor coupled to said first storage device, said second storage device and

said third storage device, said processor to process said primary document to locate an

un-selected indicator, identify said secondary document associated with said located

un-selected indicator, and attach said secondary document to said primary document to

encapsulate said secondary document within said primary document [see rejection

claim 42].

22.   As per claim 57, Thornton discloses said secondary document has a filename

and a location, wherein said primary document includes at least one word, and wherein

said processor determines at least one of said filename and said location of said

secondary document as a function of at least one of a user input and said at least one

word [Thornton, name-value pairs, col 13 line 66].

23.   As per claim 58, Thornton discloses a predetermined word is associated with at

least one of said filename and said location of said secondary document, wherein said

primary document includes said predetermined word, and wherein said processor

identifies at least one of said filename and said location of said secondary document as

a function of said predetermined word [Thornton, name-value pairs, col 13 line 66].

24.   As per claim 59, Thornton discloses said un-selected indicator includes at least one of a plurality of predetermined words, a plurality of predetermined characters, and a plurality of predetermined phrases [Thornton, character string, col 1 line 67].

25.   As per claim 60, Thornton discloses said processor determines if said primary document includes said indicator using syntactic processing [Thornton, Word, col 13 line 10].

26.   As per claim 61, Thornton discloses A document preparation system, comprising:

    a storage device;

    a set of instructions stored on the storage device; and

    a processor to execute said set of instructions to perform a method to identify a secondary document having an un-specified location relative to a primary document, said method comprising:

        processing said primary document to locate an un-selected indicator;

        identifying a secondary document associated with said located un-selected indicator; and

        attaching said secondary document to said primary document to encapsulate said secondary document within said primary document [see rejection claim 42].

27.   As per claim 62, Thornton discloses said secondary document has a filename

and a location, wherein said primary document includes at least one word, and wherein

said processor determines at least one of said filename and said location of said

secondary document as a function of at least one of a user input and said at least one

word [Thornton, file name, location, col 2 lines 1-6].

28.   As per claim 63, Thornton discloses said un-selected indicator includes at least

one of a plurality of predetermined words, a plurality of predetermined characters, and a

plurality of predetermined phrases [Thornton, character string, col 1 line 67].

29.   As per claim 64, Thornton discloses said processor determines if said primary

document includes said indicator using syntactic processing [Thornton, Word, col 13

line 10].

30.   As per claim 65, Thornton discloses A method comprising:

         processing said primary document to locate an un-selected indicator, said

primary document having a list of at least one address;

         identifying an address of said recipient associated with said located un-selected

indicator; and

         attaching said address of said recipient to said list of said at least one address

to encapsulate said address of said recipient within said primary document [see

rejection claim 42].

31.   As per claim 66, Thornton discloses said un-selected indicator includes at least

one of a plurality of predetermined words, a plurality of predetermined characters, and

a plurality of predetermined phrases [Thornton, character string, col 1 line 67].

32.   As per claim 67, Thornton discloses said primary document includes at least one

address corresponding to at least one recipient to receive said primary document,

further comprising attaching said address of said recipient to said list of said at

least one address [Thornton, file name, location, col 2 lines 1-6]

33.   As per claim 68, Thornton discloses A document preparation system comprising:

a storage device storing a set of instructions;

a processor executing said set of instructions to identify an unspecified address

of a recipient of a primary document, said primary document including a list of at least

one address corresponding to at least one recipient to receive said primary document,

by:

processing said primary document to locate an un-selected indicator, said

primary document having a list of at least one address;

identifying an address of said recipient associated with said located un-selected

indicator; and attaching said address of said recipient to said list of said at least one

address to encapsulate said address of said recipient within said primary document [see

rejection claim 42].

34.   As per claim 69, A method comprising:

processing said primary document to locate an un-selected indicator;

identifying a secondary document associated with said located un-selected

indicator; and

automatically encapsulating said secondary document within said primary

document upon identifying said secondary document [see rejection claim 42].

35.   As per claim 70 Thornton discloses determining a filename of said secondary

document; and . determining a location of said secondary document [Thornton, file

name, location, col 2 lines 1-6].

36.   As per claim 71, Thornton discloses using syntactic processing of said primary

document [Thornton, Word, col 13 line 10].

37.   As per claim 72, Thornton discloses using a user input [Thornton, a user may

specify, col 15 lines 29-41].

38.   As per claim 73, Thornton discloses using a user selection [Thornton, a user may

specify, col 15 lines 29-41].

39.   As per claim 74, Thornton discloses using syntactic processing of said primary

document [Thornton, Word, col 13 line 10].

40.   As per claim 75, Thornton discloses processing said primary document to locate

one of a plurality of pre-determined words [Thornton, character string, col 1 line 67].

41.   As per claim 76, Thornton discloses processing said primary document to locate

one of a plurality of pre-determined phrases [Thornton, character string, col 1 line 67].

42.   As per claim 77, Thornton discloses processing said primary document to locate

one of a plurality of pre-determined characters [Thornton, character string, col 1 line

67].

       Any inquiry concerning this communication or earlier communications from the examiner
should be directed to examiner *Thong Vu*, whose telephone number is (571)-272-3904. The
examiner can normally be reached on Monday-Thursday from 6:00AM- 3:30PM.
       If attempts to reach the examiner by telephone are unsuccessful, the examiner's
supervisor, *Failed, Lynn,* can be reached at (571) 272-2092. The fax number for the
organization where this application or proceeding is assigned is 571-273-8300.
       Information regarding the status of an application may be obtained from the Patent
Application Information Retrieval IPAIRI system. Status information for published applications
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PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thong Vu
Primary Examiner

THONG VU
PRIMARY EXAMINER
TECHNOLOGY CENTER 2100